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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL BAUM, AVI BLEIWEISS, and XIN WEN

Appeal 2009-0169
Application 09/630,752
Technology Center 3600

Decided: [1]March 11, 2009

Before ANTON W. FETTING, DAVID B. WALKER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

STATEMENT OF THE CASE

Daniel Baum, Avi Bleiweiss, and Xin Wen (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-64, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a system and method for accepting and storing image data from customers and then transferring the image data to a central processing facility for processing and distribution (Specification Page 3, lines 25-27).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A method of collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider, wherein the kiosk includes a computer, a data storage device and an interface for capturing digital images, wherein the data storage device includes computer readable media for storing information representative of the digital images, the method comprising:
>
> [1] accepting image information from a customer into the interface of the kiosk;
>
> [2] accepting user-identifier information into the computer, the user-identifier information corresponding to the customer;
>
> [3] accepting order information into the computer, the order information specifying a service to be provided relative to the image information;

[4] storing into a local storage connected to the computer, a digital representation of the image information and associated user identifier information and order information for each of a plurality of different customers into a data structure;

[5] in response to receipt of a first poll request at the kiosk and upon detecting availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communication medium;

[6] in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk;

[7] sending the data structure to the image-processing provider via a communications medium, and

[8] storing the data structure in the image-processing provider.

This appeal arises from the Examiner's Final Rejection, mailed July 26, 2005. The Appellants filed an Appeal Brief in support of the appeal on June 6, 2007. An Examiner's Answer to the Appeal Brief was mailed on September 6, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Rogan et al.	US 5,170,466	Dec. 8, 1992
Frey et al.	US 6,369,908 B1	Apr. 9, 2002

Ofoto.com Launches Innovative Photo Finishing Service, PR Newswire, December 13, 1999.

REJECTIONS

Claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Frey, Ofoto, and Rogan.

Claims 34-43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Frey and Ofoto.

Claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49, and 51-55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, Ofoto, and Official Notice.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 under 35 U.S.C. § 103(a) as unpatentable over Frey, Ofoto, and Rogan.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 34-43 under 35 U.S.C. § 103(a) as unpatentable over Frey and Rogan.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49, and 51-55 under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, Ofoto, and Official Notice.

The pertinent issue turns on whether Rogan describes limitation [5] and limitation [6] of claim 1 of the claimed invention.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Rogan

01. Rogan is directed towards an image and item processing system that has increased efficiency (column 1, lines 53-55).

02. Rogan includes a disk controller board that receives an image pack and then prepares that pack for transmittal to the disk drive. Data is then transferred to the specified disk (column 7, lines 26-31).

03. Rogan describes the image workstation begins the process of transferring the image by sending a command directing that the storage processor perform a retrieval of the image (column 7, lines 37-50).

Frey

04. Frey is directed towards an interactive photo kiosk for creating, storing and distributing electronic messages (column 2, lines 30-32).

05. The kiosk contains a CPU, a payment collection device, a digital camera, and removable electronic storage device (column 2, lines 40-43 and column 2, lines 62-64).

06. The process of capturing an image at the kiosk begins with the user inserting payment into the payment collection device (column 3, lines 19-20). The payment collection device can be a credit/debit card reader and the credit/debit card is verified before charges are processed to that card (column 6, lines 9-14).

07. The user is then provided with the option to store the captured image or email the captured image (column 3, lines 23-25). If the user selects to store the image, the user is further provided with an option of what kind of media to store the image on (column 3, lines 29-30).

08. The kiosk then captures an image of the user (column 3, lines 43-45).

09. Once the image is captured, the user has the option to input information, such as text information or audio information, to be associated with the image (column 4, lines 1-4, column 4, lines 33-35, and column 5, lines 1-2).

10. The CPU connects to the internet at pre-determined times and sends images to their associated email address. The CPU then stores the sent files and email address to a database (column 5, lines 43-52).

Ofoto

11. Ofoto is a provider of photo finishing services (Page 1).

12. Ofoto members are enabled to order photographic prints and have them delivered (Page 2). Customers selected order prints and the orders are processed at Ofoto's processing labs (Page 2).

13. Ofoto further provides additional services including framing (Page 2).

Facts Related To The Level Of Skill In The Art

14. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of online photographic print finishing. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

15. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

ANALYSIS

Claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 rejected under 35 U.S.C. § 103(a) as unpatentable over Frey, Ofoto, and Rogan

The Appellants argue these claims as a group.

Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Frey describes all of the limitations of claim 1 except for limitations [5-8] (Answer Pages 5-7). The Examiner found that Rogan described limitation [5], limitation [6], and limitation [8] and that one of ordinary skill in the art would found it obvious to combine Frey and Rogan in order to increase the speed of transmitting data by batch processing data during times of low network traffic (Answer Page 6). The Examiner further found that Ofoto describes limitation [7] and one of ordinary skill in the art would have been found it obvious to combine Frey, Rogan, and Ofoto in order to increase the range of services to include more than just photographic emails (Answer Page 7).

The Appellants contend (1) that none of the references disclose limitation [4] of claim 1 (Br. Page 11), (2) Rogan fails to describe limitation [5], limitation [6], and limitation [8] (Br. Page 13), (3) Frey fails to describe "removing the data structure from the local storage after the data structure has been sent to the image-processing provider" of claim 2 (Br. Page 13), (4) there is no motivation to combine Frey and Rogan (Br. Page 13), (5) Ofoto fails to describe limitation [7] of claim 1 (Br. Page 14), (6) Ofoto fails to describe limitation [5], limitation [6], and limitation [8] (Br. Page 14), and (7) there is no motivation to combine Ofoto to Frey and Rogan (Br. Page 14).

We find that the Appellants' second argument is determinative. The Appellants contend (2) Rogan fails to describe limitation [5], limitation [6], and limitation [8] (Br. Page 13). We agree with the Appellants. Limitation [5] requires

the image processing provider to poll the kiosks to determine if any of the kiosks have data that is available for upload and the kiosk returns the address of the data to the image processing center. That is, the kiosk is polled for a trigger to indicate that a transfer of data should occur. Limitation [6] then requires the image processing center submit a request to transfer the data from the kiosk. Rogan merely describes the transferring of data from one location to another location (FF 02) and explicitly describes the transferring of data to begin at the workstation (equivalent to the claimed kiosk), where the workstation sends a command to the storage processor to retrieve the data (FF 03) rather than being polled. Polling is unnecessary because the image workstation controls the process rather than the storage processor. This is in contrast to the polling in the claimed invention. As such, Rogan fails to describe limitation [5] and limitation [6] of the claimed invention, and thus the Examiner failed to establish a prima facie case of obviousness. Because the Appellants' second argument is determinative, we need not reach the remaining arguments.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, and Ofoto for the above reasons.

Claims 34-43 rejected under 35 U.S.C. § 103(a) as unpatentable over Frey and Ofoto

The Appellants argue these claims as a group.

Accordingly, we select claim 34 as representative of the group.

The Examiner found that Frey describes all of the limitations of claim 34 except for "storing the digital images at the second business location, processing prints of the stored images at the second business location, and delivering the processed prints to a customer" (Answer Page 19). The Examiner found that Ofoto describe these limitations and one of ordinary skill in the art would have found it obvious to combine Frey and Ofoto in order to increase the quality of the services provided (Answer Pages 19-20). The Examiner also found that the conditional language preceding the availability of the data structure did not require that the limitations associated to the data structure be read into the claim language (Answer Page 19, footnote referencing Answer Pages 10-11).

The Appellants contend that these claims depend from allowable independent claims and are therefore allowable (Br. Page 16). We agree with the Appellants, although their argument has a minor technical flaw, because claim 34 is independent. However, we take the thrust of the Appellants' argument to be that independent claim 34 recites the "in response to a first poll request at the kiosk" limitation found in limitation [5] and limitation [6] of claim 1. Appellants' arguments regarding these limitations were found to be sufficient to overcome the Appellants' burden *supra* and are similarly found to be sufficient to overcome the Appellants' burden of showing that the Examiner erred in rejecting claim 34 and dependant claims 35-43 under U.S.C. § 103(a) as unpatentable over Frey and Ofoto.

Claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49, and 51-55 rejected under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, Ofoto, and Official Notice

The Appellants argue these claims as a group.

Accordingly, we select claim 4 as representative of the group.

The Examiner found that Frey, Rogan, and Ofoto describe all of the limitations of claim 1, but do not describe the additional limitation of claim 4 of "accepting credit-card payment, and storing into the local storage connected to the computer, a digital representation of the credit-card information" (Answer Page 21). The Examiner took Official Notice that these features were old and well-known in the art and one of ordinary skill in the art would have found it obvious to modify Frey, Rogan, and Ofoto to include these features in order to automate the receipt of payment (Answer Page 21).

The Appellants contend that (1) these claims depend from claim 1 and were improperly rejected for the same reasons cited above (Br. Page 17) and (2) there is no motivation to combine Frey, Rogan, Ofoto, and the Examiner's Official Notice (Br. Page 17).

The Appellants contend (1) these claims depend from claim 1 and were improperly rejected for the same reasons cited above (Br. Page 17). We agree with the Appellants. The Appellants rely on their arguments in support of claim 1, which we found to be sufficient to overcome the Appellants' burden, and so have similarly sustained their burden of showing that the Examiner erred in rejecting

claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49, and 51-55 U.S.C. § 103(a) as unpatentable over Frey, Rogan, Ofoto, and Official Notice. The Examiner's taking of Official Notice of several features in these claims do not overcome the shortcomings of the references with respect to claim 1, as discussed above.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-64 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, and Ofoto is not sustained.
- The rejection of claims 34-43 under 35 U.S.C. § 103(a) as unpatentable over Frey and Ofoto is not sustained.
- The rejection of claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49, and 51-55 under 35 U.S.C. § 103(a) as unpatentable over Frey, Rogan, Ofoto, and Official Notice is not sustained.

REVERSED

LV:

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